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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,639	06/15/2001	Mark Mitchell Komfein	RD-29,249	2225
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EXAMINER				
DASS, HARISH T				
ART UNIT PAPER NUMBER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/882,639	<b>Applicant(s)</b> KORNFEIN ET AL.	
	<b>Examiner</b> Harish T. Dass	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: _____                                     |

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See

Art Unit: 3628

State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be

Art Unit: 3628

judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377.

Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the *Freeman-Walter-Abele* test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 1-15 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. The step of communicating monitoring and using Internet does not show what is down by the invention computer except communication of display, this display can be done manually with slides or slides are emailed as attachments (well known step).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-9, 11-16, 18-24, 26-30 rejected under 35 U.S.C. 102(e) as being anticipated by Limousin et al (hereinafter Limousin – US 6938242).

Re. Claim 1, Limousin discloses creating a plurality of issues and risks using a globally-accessible system [see entire document particularly, Abstract; Figures 1, 3-5, 9, 11; C1 L5-L56; C2 L10-36; C3 L65 to C4 L9; see task]; and

monitoring and tracking the plurality of issues and risks via the globally-accessible system using a plurality of color-coded (coded) visual displays graphically indicating favorable or unfavorable process progress over time [Figure 16; C3 L65 to C4 L9; C10 L31-L40 -- color-coded same as coded, the Gantt chart of figure 16 can have color attributes, for example, diamond in figure 16 represents completion date can have color green which is visible on screen or printed by color printer].

Re. Claims 3-4, Limousin discloses wherein monitoring and tracking the plurality of issues and risks using a plurality of color-coded visual displays further comprises graphically highlighting process management roadblocks (see permit approval) and wherein monitoring and tracking the plurality of issues and risks using a plurality of color-coded visual displays further comprises graphically highlighting exception status (expected first use of the medical system) [Fig. 9-11; C9 L62 to C10 L40; C11 L1-L25 – see figure 11 includes list of tasks which can be edited and lists more item (#270) ].

Re. Claims 5-7, Limousin discloses wherein the globally-accessible system comprises a globally-distributed computer network [Figure 1; C2 L41-L45; C2 L63-67; C3 L44-L47; C3 L65 to C4 L9; C5 L16-L33 – LAN and WAN are well known communication

Art Unit: 3628

networks].

Re. Claim 8, Limousin discloses globally-accessible system (Internet) may be accessed by a plurality of remote users simultaneously [Figure 1; C5 L17-L33].

Re. Claim 9, Limousin discloses creating a plurality of issues and risks using a globally-accessible system [Figures 1, 3-5, 9, 11C1 L5-L56; C2 L10-36; C3 L65 to C4 L9];

monitoring and tracking the plurality of issues and risks via the globally-accessible system using a plurality of color-coded visual displays graphically indicating favorable or unfavorable process progress over time [Figure 16; C3 L65 to C4 L9; C10 L31-L40]; and

wherein the globally-accessible system (Internet) may be accessed by a plurality of remote users simultaneously [Figure 1; C5 L17-L33].

Re. Claims 11-12, claims 11-12 are substantially same as claim 3-4, therefore claims 11-12 are rejected with same rational as claims 3-4.

Re. Claims 13-15, claims 13-15 are substantially same as claim 5-7, therefore claims 13-15 are rejected with same rational as claims 5-7.

Re. Claim 16, Limousin discloses an issue management module (model installation plan) operable for creating, storing, and graphically displaying the status of a plurality of issues [C2 L10-L23; C6 L17-L49; C1 L5-L56; C2 L10-36; C3 L65 to C4 L9];

Art Unit: 3628

a risk management module operable for creating, storing, and graphically displaying the status of a plurality of risks; a plurality of color-coded visual displays for graphically displaying the status of the plurality of issues and risks; a processor operable for manipulating information related to the plurality of issues and risks [C2 L10-L23; C3 L65 to C4 L9; C10 L31-L40]; and

a communications network operable for communicating information related to the plurality of issues and risks to and from a plurality of remote users [C2 L41-L45; C2 L63-67; C3 L44-L47; C3 L65 to C4 L9; C5 L16-L33].

Re. Claims 18-19, claims 18-19 are substantially same as claim 3-4, therefore claims 18-19 are rejected with same rational as claims 3-4.

Re. Claims 20-22, claims 20-22 are substantially same as claim 5-7, therefore claims 20-22 are rejected with same rational as claims 5-7.

Re. Claim 23, claim 23 is substantially same as claim 8, therefore claim 23 is rejected with same rational as claim 8.

Re. Claim 24, Limousin discloses an issue management module operable for creating, storing, and graphically displaying the status of a plurality of issues [C2 L10-L23; C6 L17-L49; C1 L5-L56; C2 L10-36; C3 L65 to C4 L9];



Art Unit: 3628

a risk management module operable for creating, storing, and graphically displaying the status of a plurality of risks; a plurality of color-coded visual displays for graphically displaying the status of the plurality of issues and risks; a processor operable for manipulating information related to the plurality of issues and risks [C2 L10-L23; C3 L65 to C4 L9; C10 L31-L40]; and

a communications network operable for communicating information related to the plurality of issues and risks to and from a plurality of remote users simultaneously [C2 L41-L45; C2 L63-67; C3 L44-L47; C3 L65 to C4 L9; C5 L16-L33].

Re. Claims 26-27, claims 26-27 are substantially same as claim 3-4, therefore claims 26-27 are rejected with same rational as claims 3-4.

Re. Claims 28-30, claims 28-30 are substantially same as claim 5-7, therefore claims 28-30 are rejected with same rational as claims 5-7.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3628

Claims 2, 10, 17 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Limousin in view of Martin et al, March 1987 "A Project Accountability Chart (PAC)", Journal of Systems Management (hereinafter Martin).

Re. Claim 2, Limousin discloses wherein monitoring and tracking the plurality of issues and risks using a plurality of color-coded visual displays. Limousin does not explicitly disclose graphically representing a risk probability number (RPN). However, Martin disclose this feature [see entire document, pages 6-9, particularly Exhibits, pages 6, page 7 col. 2 # 3; page 8 col. 2 – see artistic, 25% activity completion] to provide a clear statement for critically path estimates and accomplishment. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Limousin and Martin and include displaying risk number to display a clear visual management chart with probability of accomplishments.

Re. Claim 10, claim 10 is substantially same as claim 2, therefore claim 10 is rejected with same rational as claim 2.

Re. Claim 17, claim 17 is substantially same as claim 2, therefore claim 17 is rejected with same rational as claim 2.

Re. Claim 25, claim 25 is substantially same as claim 2, therefore claim 25 is rejected with same rational as claim 2.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

Ewing, 1994 "Using Microsoft Project 4 for Windows, 1994" discloses Microsoft's software used for project management using windows and how to use the software to develop, prepare project millstones, scheduling, creating and editing formatted Gantt charts.

Tommy Wedlund, Nov 2000 "Global Product Development Supported by Groupware" discloses project management tools which enabled a creation of virtual global teams and communication between them to share project activities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

9/27/05

  
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